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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1961.

## No. 509

BORG-WARNER CORPORATION,

*Petitioner,*

*vs.*

YORK-SHIPLEY, INC.,

*Respondent.*

## PETITIONER'S REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

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The Scheffer Press, Inc.—ANdover 3-6850

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Respondent's refusal to discuss or attempt to meet the questions presented by the Petition is an obvious attempt to obscure their importance. But respondent succeeds only in pointing up the soundness of the Petition.

For example, with respect to the third question presented petitioner urged (Petition, pp. 14-17) that the decision below awarded to respondent exclusive rights in the geographic word "YORK" alone as a trademark on furnaces; despite the fact that respondent stated to the Patent Office "Obviously the word 'YORK', by itself, has geographical significance, and, therefore, is not subject to exclusive appropriation as a trademark by anyone."; despite the fact that respondent in overcoming a third party's registration of that word had denied that the single word "YORK" was its mark; despite the fact that

respondent had repeatedly and publicly asserted "YORK" was not its mark; and, despite the fact that respondent had abandoned any rights it may have acquired in the single word "YORK".

Respondent doesn't meet this argument but misstates it and then argues (Br., p. 13):

> ". . . Respondent's federal registrations show, however, that in respondent's 'YORK-Yh-HEAT' registration the word 'HEAT' is disclaimed (PX 160, DX 107; Plf's. A. 325) and in its 'YORK-GAS-HEAT' registration, the word 'Gas' is disclaimed (DX 109), leaving the word YORK as the identifying word registered in both."

Thus, respondent interprets the law to be that by *disclaiming* portions of its federal registrations for its combination trademarks, it *broadened* its rights to the remaining, geographical portions of those combination trademarks. Respondent employs a combination mark "YORK-yh-HEAT" in a particular design or shield. By disclaiming "heat" except as a part of the combination mark, respondent asserts it is left with "YORK" as "the identifying word", and thus claims exclusive trademark rights in "YORK"—exclusive rights in a geographical word it has admitted is not, and cannot be, its trademark.

It is respectfully urged that any doctrine permitting the broadening of rights in a geographical word which is a part of a combination mark by disclaimer of other portions of such a mark is totally unsound and has a serious and direct impact on the administration of the Lanham Trade Mark Act in the Patent Office, and materially affects the rights of users of geographical words as trademarks or trade names.

**Similarly, with respect to the first and second questions, respondent attempts to avoid rather than to meet them.**

**As to the first question, Petitioner (Pet., pp. 9-12) pointed out that the holding of the Courts below lacked basis in that there was no finding that respondent had acquired a secondary meaning in the geographic word "YORK" identifying respondent's furnaces, before petitioner** applied that mark to its furnaces. It was further shown that such holding was in conflict with the controlling law, as announced in decisions in the Second and Sixth Circuits.

The second question related to the requirement of Rule 52 (a) of the Federal Rules of Civil Procedure that a trial court make explicit findings on every material issue and is based on the District Court's failure to make the necessary finding as to *when* respondent's alleged secondary meaning was acquired.

Respondent refuses to discuss these issues. It erroneously asserts (B., p. 10) that the Court of Appeals held that the "records and findings of the District Court showed that respondent's mark had acquired a secondary meaning prior to petitioner's entry into the furnace market * * *."

Respondent alludes to the combining by the Court of Appeals of Findings 27 and 38 (P.A., 352, 354) and that court's holding that together they constitute (App. B., pp. 6a-7a) "a sufficient finding as to secondary meaning." However, each of the findings referred to by the Court of Appeals can be searched in vain for any indication that respondent acquired the alleged secondary meaning *prior* to petitioner's use of the mark on furnaces. Respondent does not explain the magic of its logic whereby two findings, each deficient in the same respect, can be combined and the common deficiency thereby cured.

The Court of Appeals recognized that "prior use is not sufficient" and secondary meaning must appear (App. B pp. 6a-7a); but it held, contrary to the decisions of other courts of appeals, that prior use, together with eventual secondary meaning, whenever acquired, was sufficient. It did not require, as would other courts, that the secondary meaning of a geographical word be acquired prior to petitioner's use of the geographical word on residential furnaces. The resulting conflict in decisions is one which this Court should resolve. The importance of the question to the public is obvious. Users of geographical and other words in the public domain should know what monopolistic rights in such words can be acquired. The public should know the manner in which such words can be exclusively appropriated.

Respectfully submitted,

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